

reference made in the previously-filed Office Action Response of April 23, 2001. M.P.E.P.

707.07(f) states, in pertinent part, the following:

Where the requirements are traversed, or suspension thereof requested, the examiner should take proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

In this regard, M.P.E.P. 707.07(f) indicates that the Office Action should take note of the Applicant's argument regarding the rejections that rely upon the '987 reference and answer the substance of it. This is consistent with the purpose of aiding the Applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. §1.104(a)(2). The Office Action did not comply with this requirement, and the Applicant was not afforded the opportunity to judge the propriety of the rejections based upon the '987 reference and to form a response thereto.

Specifically, the '987 reference was cited in a Final Office Action dated March 19, 2001, and a response thereto was filed on April 23, 2001, which included arguments directed to the impropriety of the use of the '987 reference as a Section 102(b) reference. In response, an Office Action was mailed on May 9, 2001, removing the rejections based upon the '987 reference and removing the finality of the Final Office Action dated March 19, 2001. In the Office Action mailed on March 18, 2002, to which this response is directed, the "Response to Arguments" section is apparently directed to arguments filed in an Office Action mailed on January 19, 2001, and ignores the arguments made in the Office Action response of April 23, 2001. In view of the above, Applicant submits that the Examiner failed to adequately respond to the Applicant's arguments as required by the M.P.E.P. and 35 U.S.C. §132. Therefore, Applicant requests that the claim rejections be removed. In the alternative, Applicant requests that the Examiner respond to the Applicant's arguments filed on April 23, 2001, the substance of certain aspects thereof being addressed below, and that the Applicant have an opportunity to respond thereto.

In regard to the merits of the rejections, which are all based upon the '987 reference, Applicant refers to the arguments made in the Office Action Response filed on April 23, 2001.

These arguments resulted in new grounds for rejection in a subsequently-mailed Office Action and removal of the '987 reference from any grounds for rejection.

Notwithstanding the above, Applicant respectfully traverses the Section 102(b) rejection because the Office Action failed to cite a portion of a reference that teaches or suggests every element of the presently-claimed invention. For example, the Office Action refers to column 3, lines 39-56 and column 4, lines 28-31 in support of the '987 reference allegedly teaching a center-offset polishing process. However, upon review of these portions of the '987 reference, Applicant can find no discussion of a center-offset polishing process taught in the context of the instant invention. For example, page 3 of the instant application discusses center-offset conditions wherein portions of a wafer are polished at different rates. These center-offset conditions may, for example, be dependent upon factors such as the condition of the pad and pressure applied to the wafer. The cited portions of the '987 reference, however, appear to only refer to an axis of rotation offset, which is common to such CMP applications and which does not teach or suggest the center-offset conditions and uses thereof to which the present invention is directed. Furthermore, there is no teaching or suggestion of conditioning the pad as a function of such a center-offset condition. In addition, Office Action has not cited a portion of the '987 reference that teaches or suggests positioning the wafer carrier misaligned with respect to the pad as a function of the wafer being polished in a center-offset manner. Therefore, the Office Action has failed to establish a *prima facie* Section 102(b) rejection, and Applicant requests that it be removed.

Applicant traverses the Section 103(a) rejections for the reasons stated above in connection with the Section 102(b) rejection because the rejections rely upon the '987 reference as the primary reference. A *prima facie* obviousness rejection under Section 103(a) requires that the Office Action provide teaching or suggestion of every element of the claimed invention. In this regard, the Section 103(a) rejection fails to cite references that teach or suggest every element of the instant invention. Therefore, the Office Action failed to establish a *prima facie* case of obviousness, and the Section 103(a) rejection should be removed.

Applicant further traverses the Section 103(a) rejection because the Office Action failed to cite evidence of motivation in the prior art for modifying the '987 reference with the '462 reference or with the '947 reference. Relevant case law indicates that, without such evidence,

such a Section 103(a) rejection is unmotivated and cannot stand (*see, e.g., In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)). As acknowledged on page 3 of the Office Action, the '987 reference fails to disclose that arranging a conditioning wheel comprises thinning the pad. In a hindsight attempt to arrive at the presently-claimed invention, the Office Action has asserted teachings of the '462 reference but failed to cite any evidence in support of modifying the '987 reference with the asserted teachings. Similarly, the Office Action acknowledges on page 3 that the '987 reference fails to disclose a supply arranged to supply conditioning material to a polishing pad and the conditioning material being water. Also in a hindsight attempt to arrive at the presently-claimed invention, the Office Action asserted teachings of the '947 reference but failed to cite any evidence in support of modifying the '987 reference with the asserted teachings. Therefore, the Section 103(a) rejections are unmotivated and Applicant requests that they be removed.

In view of the above, Applicant believes that the rejections are improper and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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